

Serial No. 09/681,593  
Filed: May 3, 2001  
Page 8 of 12

Examiner: Jordan Golinkoff  
Group Art Unit: 2174

### **Remarks**

The following remarks are responsive to the Office Action mailed November 19, 2003, Paper No. 4.

Claims 1-23 were in the application as filed. Applicant acknowledges with thanks the Examiner's determination that claims 8, 17 and 23 are allowable if rewritten into independent form. Minor amendments are made to the specification as suggested by the Examiner. No new matter is added by the amendments.

In this Office Action, the Examiner has objected to the specification and has rejected claims 1-7, 9-16 and 18-22 under 35 U.S.C. §102(e) as allegedly unpatentable over a Microsoft Excel spreadsheet created by the Examiner. These rejections are respectfully traversed. Further consideration and re-examination of the application is requested in view of the foregoing amendments and the following remarks.

### **Objections to the Specification**

The Examiner has objected to the title of the invention as allegedly being not descriptive. The Examiner requires that the title be amended to be clearly indicative of the invention to which the claims are directed and that the title should be made shorter and more concise. The Applicant has amended the title in accordance with the Examiner's recommendations and believes that the objection has been overcome.

The Examiner has objected to the disclosure because of an informality at page 4, paragraph [0009], 1<sup>st</sup> sentence, which includes the text "any of the preceding method claims". Applicant has amended this paragraph herein and believes that this objection has been overcome as well.

### **Claim Rejections - 35 USC § 102**

Claims 1-7, 9-16, and 18-22 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by what the Examiner terms "Microsoft Excel." The rejection is traversed.

First, to the extent that Microsoft Excel is not a patent application or patent, it cannot be prior art under §102(e). There may be some other statutory provision that gives effect to Microsoft Excel as prior art, but §102(e) is not it.

Serial No. 09/681,593  
Filed: May 3, 2001  
Page 9 of 12

Examiner: Jordan Golinkoff  
Group Art Unit: 2174

Second, it is not clear that the version of Microsoft Excel to which the Examiner refers was published prior to the critical date of the present application. Applicant concedes that Microsoft Excel is a spreadsheet program from Microsoft Corporation, and that some versions of Microsoft Excel were published prior to the critical date, but nothing in what the Examiner refers to as Fig. 1 in the document entitled "Microsoft Excel 2000 Screen Dumps" indicates the publication date of the illustrated version 9.0.4402 SR-1.

Third, some of what the Examiner illustrates in Figs. 2, 5, and 7 relate to Microsoft Word, which is not the cited Microsoft Excel 2000. It is unclear if the Examiner relies also on a version of Microsoft Word as a basis for the present rejection, and if so, what that basis is (anticipation, obviousness, etc.).

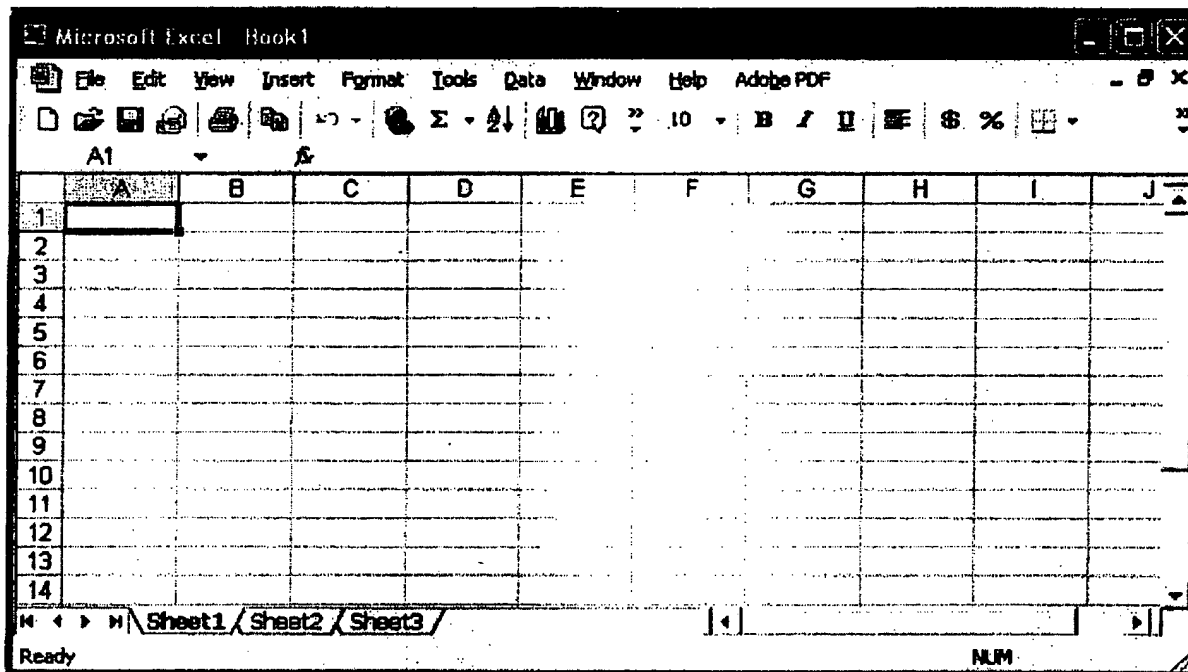
Fourth and most importantly, what the Examiner illustrates in Figs. 3-7 of the document entitled "Microsoft Excel 2000 Screen dumps" is not prior art to this invention. Figs. 3, 4, and 6 appear to be screen dumps of a Microsoft Excel document prepared by the Examiner, and Figs. 5 and 7 appear to be screen dumps of a Microsoft Word document prepared by the Examiner (see, e.g., the referenced hyperlink in Fig. 4, to-wit: C:\WINNT\Profiles\jgolinkoff\Desktop\Jordan's Work\Patent Related\09681593\_Williams\CLAIMS\_Williams\_doc - (3) [*emphasis added*]). A document prepared by the Examiner after the effective filing date of the application cannot by *definition* be prior art under any interpretation of 35 U.S.C. § 102.

The screen dumps in Figs. 3-7 on which the Examiner relies for the present rejection are unquestionably a hindsight reconstruction of the invention *because the documents were prepared by the Examiner after reading the Applicant's patent application.* See, for example, the file name in Fig. 3 entitled "Rejections\_Williams.xls" – clearly a file name referring to the Applicant's last name (Williams) and the rejections the Examiner intended to make. Fig. 4 contains a "quick tip" box with the file name of a hyperlink showing a path containing subdirectories of "jgolinkoff", "Jordan's Work", "09681593\_Williams", etc. The references to "jgolinkoff" and "Jordan's Work" suggest that Examiner Jordan Golinkoff created the document. The reference to "09681593\_Williams" clearly identifies the serial number (09/681,593) and Applicant's last name (Williams) of this case, filed May 3, 2001. A document created by the Examiner *after* the filing date of the application cannot be prior art. It is inappropriate for the Examiner to rely on Figs. 3-7 of his screen dumps for the present rejection.

Serial No. 09/681,593  
Filed: May 3, 2001  
Page 10 f 12

Examiner: Jordan Golinkoff  
Group Art Unit: 2174

Regardless of the particular versions of Microsoft Excel and Microsoft Word that the Examiner used in his reconstruction, Applicant concedes that some version of both programs constitute prior art as printed publications under 35 U.S.C. § 102(b). Microsoft Excel comprises a spreadsheet with a matrix of cells into which values, data, text, links, or functions can be inserted. A true and accurate example of Microsoft Excel follows:



**MS Excel Screen Dump**

Microsoft Word is a word processing program that enables the creation, editing, and formatting of text and graphic documents, including tables.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also, MPEP 706.02(j) and 2143-2143.03. Absent the identification of a teaching, motivation, or suggestion expressly contained in prior art references, the asserted prior art is nothing but an exercise in impermissible hindsight reconstruction of an applicant's claimed invention. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The Examiner has

Serial No. 09/681,593  
Filed: May 3, 2001  
Page 11 of 12

Examiner: Jordan Golinkoff  
Group Art Unit: 2174

done this in the post-filing creation of a document and the subsequent citation of the fictional document against the Applicant's invention. Moreover, neither Microsoft Excel nor Microsoft Word teach or suggest the forming, determining or inserting steps of claim 1, or the array of claim 5, or the matrix of claim 9. Inasmuch as claims 1, 5, and 9 are not anticipated or obvious over the relevant cited prior art, they are patentable. Similarly, all of the remaining rejected claims depend directly or indirectly from claims 1, 5 and 9 and are therefore patentable for the same reasons that claims 1, 5 and 9 are patentable.

#### **Applicant's Objection to Examiner's Form PTO-892**

The Examiner included a Form PTO-892 in the November 19, 2003, Office Action, which included, on Line U, the text "Microsoft Excel 2000 Screen Dumps (pages 1-4, 1999)". The Applicant requests that this line be stricken from the form since the cited document is not prior art against this case and is an Examiner-created document, first created after the filing date of the application. Line U also contains an alleged publication date of 1999 that is unsupported for the reasons set forth above.

Thus, it is requested that Line U be stricken from the Form PTO-892 in this case.

#### **ALLOWABLE SUBJECT MATTER**

The Applicant acknowledges with thanks the Examiner's determination that claims 8, 17, and 23 are allowable if rewritten in independent form. However, since all claims in the application are allowable as filed, claims 8, 17, and 23 are allowable without amendment.

#### **CONCLUSION**

All claims are patentable. Early notice of allowability is respectfully requested. Any questions concerning the foregoing may be directed to the undersigned

Serial No. 09/681,593  
Filed: May 3, 2001  
Page 12 of 12

Examiner: Jordan Golinkoff  
Group Art Unit: 2174

Respectfully submitted,

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